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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,607	11/21/2001	Masahiro Imoto	1830/50520	4194

23911 7590 04/09/2003

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EXAMINER
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RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>10/009,607</b>	Applicant(s) <b>Imoto et al.</b>	
Examiner <b>Deepak Rao</b>	Art Unit <b>1624</b>	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Nov 12, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-34 /are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ /are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ /are allowed.
- 6)  Claim(s) \_\_\_\_\_ /are rejected.
- 7)  Claim(s) \_\_\_\_\_ /are objected to.
- 8)  Claims 1-34 /are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
 a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

Claims 1-34 are pending in this application.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-34, drawn to compounds of formula (I) wherein the ring is a thiazolyl, thiazolidinyl or oxazolidinyl (i.e., -Y-X- is -CH<sub>2</sub>-CH<sub>2</sub>-O-, -CH<sub>2</sub>-CH<sub>2</sub>-S- or -C(R<sup>1</sup>)=C(R<sup>2</sup>)-S), corresponding composition and method of use.

Group II, claim(s) 1-34, drawn to compounds of formula (I) wherein the ring is a dihydro- or hexahydropyrimidine (i.e., -Y-X- is -CH<sub>2</sub>-CH<sub>2</sub>-CH<sub>2</sub>-NH- or -C(R<sup>9</sup>)=C(R<sup>10</sup>)-C(R<sup>11</sup>)=N-), corresponding composition and method of use.

Group III, claim(s) 1-34, drawn to compounds of formula (I) wherein the ring is a imidazole or imidazoline (i.e., -Y-X- is -CH<sub>2</sub>-CH<sub>2</sub>-NH- or -C(R<sup>7</sup>)=C(R<sup>8</sup>)-N=), corresponding composition and method of use.

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Group IV, claim(s) 1-34, drawn to compounds of formula (I) wherein the ring is a dihydropyridazine (i.e., -Y-X- is  $-N=C(R^5)-C(R^6)=CH-$ ), corresponding composition and method of use.

Group V, claim(s) 1-34, drawn to compounds of formula (I) wherein the ring is a dihydropyridine or piperidine (i.e., -Y-X- is  $-CH_2-CH_2-CH_2-CH_2-$  or  $-CH=C(R^3)-C(R^4)=CH-$ ), corresponding composition and method of use.

Group VI, claim(s) 1 and 3-34, drawn to compounds of formula (I) wherein the ring is a hexahydro-1,3-oxazine (i.e., -Y-X- is  $-CH_2-CH_2-CH_2-O-$ ), corresponding composition and method of use.

Group VII, claim(s) 1 and 34, drawn to compounds of formula (I) wherein the ring is a pyrrolidine (i.e., -Y-X- is  $-CH_2-CH_2-CH_2-$ ), corresponding composition and method of use.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The compounds of Groups I-VII are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I were anticipated, the anticipatory reference would not necessarily render obvious the other groups II-VII or vice-versa. They are not art recognized equivalents and require separate searches in the literature.

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Unity of invention exists only with certain categories of invention as set forth in PCT

Rule 13. Note that compounds, corresponding compositions, a method of use and a process of making are considered to form a single inventive concept as required by PCT Rule 13.1, 37 CFR 1.475(d). Additional Groups drawn to compounds as outlined above are not so linked as they would require separate searches in the prior art and would be expected to raise different issues of novelty and nonobviousness. See PCT Rule 13.3 and 37 CFR 1.141(a), the latter of which states two or more independent, distinct inventions may not be claimed in one application.

In view of lack of unity of invention, the requirement for restriction for examination purposes indicated is proper.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant is required to elect a single disclosed species falling within the elected group, even though this requirement is traversed. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Due to lengthy and complex nature, the restriction requirement is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

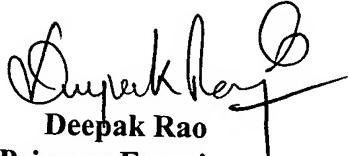
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Deepak Rao  
Primary Examiner  
Art Unit 1624

April 6, 2003